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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,177	12/03/2003	Mary C. Tannenbaum	005708/P010US/08008819	5985

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
2200 ROSS AVENUE  
SUITE 2800  
DALLAS, TX 75201-2784

EXAMINER

CHOW, MING

ART UNIT PAPER NUMBER

2645

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/727,177		TANNENBAUM, MARY C.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Ming Chow		2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37,39,41-44 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37,39,41-44 and 48-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. The reply filed on 8-9-05 is not fully responsive to the prior Office Action because:  
Applicant failed to address the objections to claim 37 as stated in the previous Office Action (see also same objections below). The Examiner waives the requirements for the Applicant to respond to the objections within one month. However, the Applicant is requested to address the objections in the next reply, if any.

***Claim Objections***

2. Claim 37 recites "the part of said message recipient". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “said message” (line 4) is not clearly defined. It is unclear the claimed refers to “messages that do not have controlled play times” (line 2 claim 8) or “messages having associated therewith a controlled play time” (line 3 claim 1).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5, 8-34, 36, 37, 39, 41-44, 48-51 are rejected under 35 U.S.C 102(e) as being anticipated by Wood et al (US: 6816703).

For claims 1, 19, 28, 44, Wood et al teach on column 3 line 61-63, a memory for storing personalized information (claimed “messages”) for playing at a predetermined time.

Wood et al teach on column 15 line 39-40, alarm clock (claimed “device”) for playing the personalized information.

Regarding claims 2, 34, Wood et al teach on column 3 line 63-67, the alarm sounds (claimed “messages are received by a message recipient”) when the user is sleeping . Therefore, the message recipient did not perform any action for playing the message.

Regarding claim 3, see column 4 line 3.

Regarding claim 4, see column 7 line 39-41.

Regarding claim 5, see column 7 line 37-41.

Regarding claim 8, see column 2 line 28, a processor.

Wood et al teach on column 3 line 66 to column 4 line 9, the personalized information (claimed “messages that do not have controlled play times”) is broadcasted to the user after the alarm sounds. The predetermined time is associated with the alarm but not the personalized information. Wood et al further teach “turning off the alarm can initiate the broadcast of the personalized information”. The time of “turning off the alarm” is not a predetermined time. Therefore, there is no predetermined time associated with the personalized information.

Regarding claim 9, the profile is the claimed “information available at the time a received message is played”.

Regarding claim 10, Wood et al teach on column 4 line 65 to column 5 line 24, reminder message. The sender and the recipient are the same person. The profile is created by the user (sender/recipient). The customized message (claimed “selected other message”) is controlled by information received from the sender.

Regarding claims 11, 12, 30, 31, 41, Wood et al teach on column 3 line 66 to column 4 line 9, the personalized information is broadcasted to the user after the alarm sounds. Wood et al further teach “turning off the alarm can initiate the broadcast of the personalized information”. Therefore, the selection of personalized information is controlled, in part (indirectly, see claim 11), by a clock (claimed “sensor”) which sets the alarm.

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Wood et al teach on column 3 line 25-39, the server computer retrieve and arrange personalized information and send it to the client computer via internet. The internet is the claimed “sensor”.

Regarding claim 13, Wood et al teach on column 3 line 37-39, a message is played continuously for a period of time.

Regarding claim 14, different messages must be stored at different memories (reads on claimed “messages are received by a plurality of memories”). Wood et al teach on column 10 line 22-24, different messages for different users.

Regarding claims 15, 26, 29, 36, 39, 42, 49, 50, Wood et al teach on column 4 line 3-9, depress a button to turn the alarm off (reads on claimed “override control for playing”).

Regarding claim 16, messages are stored at the server for downloading.

Regarding claims 17, 43, see column 8 line 22-25.

Regarding claims 18, 27, see column 5 line 1-24, the reminder is played at the recipient specific time category.

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Regarding claim 20, see column 4 line 7-9, the same alarm message is played at different time (claimed “additional message playing times”) when the user neglects to turn off the alarm message.

Regarding claim 21, see column 5 line 1-2. Reminders messages (different messages) for holidays, birthdays, anniversaries, meetings (different playing times).

Regarding claims 22, 24, Wood et al teach on column 3 line 26-28, personalized information are downloaded to the client computer via internet. Wood et al teach on column 4 line 65 to column 5 line 23, personalized information includes schedule (claimed “playing time”) and message to be played.

Regarding claims 23, 25, Wood et al teach on column 7 line 8-23, the personal profile includes user preferences including subjects (claimed “identity”).

Regarding claim 32, see column 7 line 35-41.

Regarding claim 33, Wood et al teach on column 5 line 9-12, designating only a day (claimed “duration of playback time”).

Regarding claim 37, all rejections as stated in claim 1 above apply.

Wood et al teach on column 5 line 9-12, time and date.



Regarding claim 48, see column 9 line 24-27. The inserted scores of team 1 and team 2 are not available at the time the pre-recorded audio portion is created.

Regarding claim 51, see column 11 line 1-23.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al as applied to claim 1 above.

Wood et al failed to teach “message contains a call-back number”. However, the message content is a “Decide Choice”.

Wood et al teach on column 2 line 37, transceivers (claimed “transmitter”).

Regarding “a response to a played message”, Wood et al teach on column 8 line 50-65, the user could log in and talk to other users via on-line chat. Whether the chat is a response to a

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played message is a “Decide Choice” depending on the content of played message and the content of on-line chat. Further, “Office Notice” is taken that using on-line chat to respond to a message is old and well known to one skilled in the art.

Wood et al teach on column 8 line 41-49, devices for input of the on-line chat (claimed “response”).

It would have been obvious to one skilled at the time the invention was made to modify Wood et al to have the “message contains a call-back number” and “a response to a played message” such that the modified system of Wood et al would be able to support the system users a convenient means of responding to the received messages.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al as applied to claim 1 above.

Wood et al failed to teach “controlled play time is a plurality of different times”. However, the time to play the message is a “Decide Choice”. Further, “Official Notice” is taken that setting different time for playing messages as alarms is old and well known to one skilled in the art.

It would have been obvious to one skilled at the time the invention was made to modify Wood et al to have the “controlled play time is a plurality of different times” such that the modified system of Wood et al would be able to support the system users flexibilities of setting different time for playing the messages.

***Response to Arguments***

7. Applicant's arguments filed on 8/9/05 have been fully considered.
  - i) New grounds of rejections necessitated by the amendments have been stated above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (571) 272-7535. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

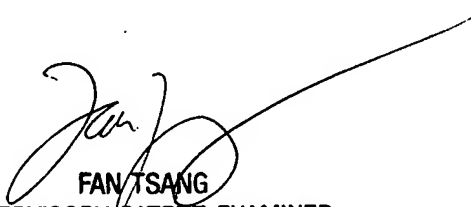
**Or faxed to Central FAX Number 571-273-8300.**

Patent Examiner

Art Unit 2645

Ming Chow

(im)

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600